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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,926	01/18/2001	Alan John Lunn	12805-002001	9930
26161	7590	01/10/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110				NGUYEN, ANTHONY H
		ART UNIT		PAPER NUMBER
		2854		

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/764,926	LUNN, ALAN JOHN
	Examiner Anthony H Nguyen	Art Unit 2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 and 33-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-31, 33-57 and 73-86 is/are allowed.
- 6) Claim(s) 58, 59 and 66-72 is/are rejected.
- 7) Claim(s) 60-65 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/6/2004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 06, 2004 has been entered.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 58, 59 and 66-70 are rejected under 35 U.S.C. 102(a) as being anticipated by Troester (US 6,135,022).

With respect to claims 58, 66 and 68, Troester teaches a marking device 10 having a housing 50 (Fig.3), a frame pivotally mounted in the housing about an axis 30, a marking head 14 which includes a head pin 12 that is actuated by a solenoid (not shown, Troester, col.10 line 13) and mounted in the carriage 15 which is moved parallel to the pivoted axis by a motor 28 and a motor 22 used to pivot the frame in a substantially orthogonal direction and a handle 82 (Fig.4B). Note that the elements of Troester are contained in the housing therefore the recoils of the marking head do not cause moments about the device's center of gravity.

With respect to claim 59, Troester teaches the use of a console or a controller 70, a handle 82 having a trigger 84 for operating the device as shown in Figs. 4A and 4B.

With respect to claim 67, Fig.3 of Troester shows the housing 50 having a window (no reference) through which the marking head 14 protrudes between the standoffs 48.25-27 and 42-44

With respect to claims 69 and 70, Troester teaches the head carriage 15 on which the marking head 14 is mounted for sliding along the guide rods or rails 24 and 26 or the first direction.

Claims 71 and 72 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Wadge (US 6,263,980).

With respect to claim 71, Troester teaches all that is claimed, except the housing which is a clamshell housing. However, Wadge teaches a power tool 2 having a clamshell housing 4 that includes ribs 30 which function as a bearing bush to secure a motor 22 in place. In view of the teaching of Wadge, it would have been obvious to one of ordinary skill in the art to modify the housing of the marking device of Troester by substituting the clamshell housing as taught by Wadge for simplicity of producing a housing of a marking device. With respect to claims 72, the use of a disc spring disposed between two elements such as a pin and a housing to take up any tolerance between the two elements is well known in the art.

Response to Arguments

Applicant argues that the new claims 58-80 are allowable over the prior art of record is not persuasive.

As explained above, Troester meets the structure as recited in claims 58, 59 and 66-70, and the combination of Troester and Wadge renders obvious the structure as recited in claims 70 and 71.

Allowable Subject Matter

Claims 1-31, 33-57 and 73-86 are allowable.

Claims 60-65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 1 and 56, the prior art of record does not teach the frame pivotally connected to a housing about the first axis and the housing which supports the frame and second motor with respect to one another.

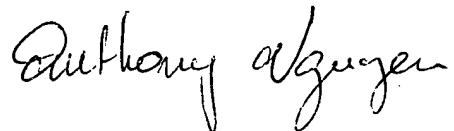
With respect to claims 61 and 73, the prior art of record does not teach the screw of the first motor being fixed in the frame.

With respect to claims 63 and 80, the prior art of record does not teach the screw of the second motor being fixed in the clevis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.



Anthony Nguyen
1/5/05
Patent Examiner
Technology Center 2800